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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,566	02/19/2002	Audrey Goddard	P 2534-3	4737

9157 7590 06/21/2004
GENENTECH, INC.
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EXAMINER

JIANG, DONG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,566

Applicant(s)

GODDARD ET AL.

Examiner

Dong Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Currently, claims 1-30 are pending.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-19, drawn to an isolated DNA molecule, a vector comprising same, a host cell thereof, and a process for recombinantly producing the encoded polypeptide.

Group II, claim(s) 20-28, drawn to an isolated polypeptide.

Group III, claim(s) 29 and 30, drawn to an antibody to the polypeptide.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Although the polypeptide of Group II is encoded by the DNA molecule of Group I, neither the DNA molecule nor the polypeptide encoded thereby is an advance over the prior art. For example, it is apparent that Ford et al. (US6,294,655) discloses a nucleic acid (SEQ ID NO:4), and a polypeptide (SEQ ID NO:5) encoded thereby, wherein the amino acid sequence of the polypeptide is 100% identical to SEQ ID NO:13 of the present invention (See appended computer printout of sequence search results). The Ford reference renders claim 1, among the other, not novel. Thus the technical feature of the DNA molecule is not special and the groups are not so linked under PCT Rule 13.1. Further, the antibody of group III is a physically and functionally distinct chemical entity, and shares neither structure nor function with the DNA molecule, and thus, it does not share the same technical feature with the main invention within

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the meaning of PCT Rule 13.2 and thus do not relate to a single invention concept within the meaning of PCT Rule 13.1.

2. Furthermore, regardless of which Invention applicants elect above, further **restriction** is required under 35 U.S.C. 121 and 372:

A. Elect *one* SEQ ID NO from the following: SEQ ID NO:5, 7, 10, 13, 16, 19, 21, or 25.

The different SEQ ID NOs as listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Each of SEQ ID NOs represents a unique and structurally distinct chemical entity, and the SEQ ID NOs are unrelated, each to each other. Therefore, they do not share a special technical feature within the meaning of PCT Rule 13.2 and thus do not relate to a single invention concept within the meaning of PCT Rule 13.1.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention from Groups I-III, and an election of the invention from Group A, to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is advised that neither I-III nor A is species election requirement; rather, each of I-III, and A is a restriction requirement.

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Advisory Information

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

A handwritten signature in black ink, reading "Lorraine Spector". The signature is written in a cursive style with a large, looping initial "L".

**LORRAINE SPECTOR
PRIMARY EXAMINER**

Dong Jiang, Ph.D.
Patent Examiner
AU1646
6/14/04